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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,685	11/15/2001	Menashe Shahar	P-3439-US	7189
27130	7590	11/06/2003	EXAMINER	
EITAN, PEARL, LATZER & COHEN ZEDEK LLP 10 ROCKEFELLER PLAZA, SUITE 1001 NEW YORK, NY 10020			SHAW, SHAWNA JEANNINE	
			ART UNIT	PAPER NUMBER
			3737	

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/987,685	Applicant(s) SHAHAR ET AL.	
	Examiner Shawna J. Shaw	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33,38,39,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 34-37,40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,13-22,25-33,38,39,42 and 43 is/are rejected.
- 7) ☒ Claim(s) 6-12,23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. Applicant's election of Group I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The disclosure is objected to because of the following informalities: It appears that "ear dram" on pages 6 and 7 is misspelled. Appropriate correction is required.

### ***Claim Objections***

5. Claims 1, 3, 15-22, 23, 24, 26 and 33 are objected to because of the following informalities: Claim 1 is incomplete in that it is directed to a system for detecting *and*

*diagnosing* ear related conditions, however a structure configured for making a diagnosis is not set forth. Furthermore, it appears that the model used by the processor requires reference value in order to make a diagnosis. In claim 3, it is unclear how the lamp is capable of obtaining a spectrum of reflected light. Claims 15-22 and 26 are directed to an apparatus claim but fail to set forth any structural limitations. In claim 17, it is unclear what "decision" has previously been made. In claims 23 and 24, it appears that "reflectance" is misspelled. In claim 33, it is unclear what steps are being claimed. Appropriate correction is required.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lamp must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Regarding the present invention, the examiner interprets "spectral analytical instrument" as any instrument(s) that analyze(s) a spectrum not excluding cameras and processors.

7. Claims 1-3, 13, 15-22, 31-33, 38, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Shirrod et al.

Regarding claims 1-3, 13, 15-22, 31-33, 42 and 43, Shirrod et al. teaches an otoscope (12) for obtaining a spectrum of reflected light from the ear of a subject (col. 6 lines 33-37 and element 46) and including a processor *capable* of translating the obtained spectrum to one or more values related to the condition of the ear (col. 8 lines 39-48 and element 50) and for comparison to a standard available through a database or a remote network (col. 12 line 57 – col. 13 line 5). See also col. 7 lines 13-33 and col. 12 line 57 – col. 13 line 5. Shirrod et al. also teaches lamp (22), light conveyors (i.e., optics) and display (54).

Regarding claim 38, Shirrod et al. teaches illuminating inside the ear with an otoscope, obtaining a spectrum of reflected light and converting to at least one digital value (col. 6 lines 33-39, col. 8 lines 39-45), and calculating one or more output values by comparing to at least one reference value (col. 12 line 57 – col. 13 line 5).

8. Claims 1-3, 5, 13-22, 29-33, 38, 39, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheehan et al.

Regarding claims 1-3, 5, 13-22, 29-33, 42 and 43, Sheehan et al. teaches a portable otoscope including a device capable of obtaining a spectrum of reflected light (col. 5 lines 46-67), a processing unit (208) *capable* of translating the spectrum of

reflected light to one or more output values related to the condition of the ear and for comparing with a reference value stored in memory or available via the Internet (col. 7 lines 4-11 and 19-29). Sheehan et al. further disclose a lamp (205), a light fiber, a user interface (212) and an LCD display (220).

Regarding claims 38 and 39, Sheehan et al. teaches illuminating inside the ear with a portable otoscope, obtaining a spectrum of reflected light and converting to at least one digital value (col. 5 lines 46-67), and calculating one or more output values by comparing to at least one reference value (col. 6 lines 46-59, col. 6 line 66 – col. 7 line 11 and col. 7 lines 19-29). Sheehan et al. further provides initial data regarding patient information (col. 3 lines 54-60).

### ***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirrod et al.

Regarding claim 4, Shirrod et al. differs from the claimed invention in that a halogen lamp is not addressed expressly. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a halogen lamp because Applicant has not disclosed that a halogen lamp provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either a white light source or a halogen lamp because both perform the same function of illuminating the ear of a subject to obtain information relating to the health of the ear. Further regarding claim 39, although Shirrod et al. discloses providing patient records, the step of inputting information such as the side of the ear is not addressed explicitly. However, it would have been obvious at the time the invention was made to a person of ordinary skill in the art to indicate which ear the data corresponds to in order to provide more accurate and efficient subsequent diagnoses as appreciated in the art.

10. Claims 4 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheehan et al.

Regarding claim 4, Sheehan et al. differs from the claimed invention in that a halogen lamp is not explicitly addressed. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to

use a halogen lamp because Applicant has not disclosed that a halogen lamp provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either a wavelength specific LED or a halogen lamp because both perform the same function of illuminating the ear of a subject to obtain information relating to the health of the ear.

Regarding claims 25-28, although Sheehan et al. teaches an LCD display and input buttons (216) or menu-control system (col. 5 lines 1,2), a numeric keyboard is not addressed expressly. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a numeric keyboard because Applicant has not disclosed that a numeric keypad provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either input buttons, menu-control input or a numeric keyboard because all perform the same function of allowing a user to input information into a patient file.

#### ***Allowable Subject Matter***

11. Claims 6-12 and 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.




**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawna J. Shaw whose telephone number is (703) 308-2985. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Shawna J. Shaw  
Primary Examiner  
10/30/03